



Atty. Dkt. No. 029318-0998

*IN THE UNITED STATES PATENT AND TRADEMARK OFFICE*

Applicants: Robert G. Reed et al.

Title: SYSTEM AND METHOD FOR MILLING MATERIALS

Appl. No.: 10/732,801

Filing Date: 12/11/2003

Examiner: Mark Rosenbaum

Art Unit: 3725

TERMINAL DISCLAIMER FOR U.S. PATENT NO. 6,742,734

Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Petitioner, Elan Pharma International Ltd., having its principal place of business at Treasury Building, Lower Grand Canal Street, Dublin 2, Ireland (and previously located at Wil House, Shannon Business Park, Shannon, Co. Clare, Ireland), represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application No. 10/732,801, which is a continuation-in-part of U.S. Application No. 10/162,333, filed on June 4, 2003, now U.S. Patent No. 6,742,734, which claims benefit of U.S. provisional Application No. 60/295,965, filed on June 5, 2001. This application is owned by Elan Pharma International Ltd. by virtue of an Assignment from the inventors to Elan Pharma International Ltd. recorded on May 10, 2004, at Reel/Frame 015313/0570 (EXHIBIT 1)

Further, Petitioner represents that it is the owner of U.S. Patent No. 6,742,734 for "System and Method for Milling Materials," which issued on U.S. Application No. 10/162,333, filed on June 4, 2003, which claims benefit of U.S. provisional Application No. 60/295,965, filed on June 5, 2001. This application is owned by Elan Pharma International Ltd. by virtue of an Assignment from the inventors to Elan Pharma International Ltd. recorded on September 3, 2002, at Reel/Frame 013263/0399 (EXHIBIT 2).

Petitioner respectfully disagrees with the Examiner regarding the obviousness-type double patenting rejection given in the Office Action dated August 8, 2005. This Terminal Disclaimer is being filed for the sole purpose of advancing the prosecution of this case.

Petitioner hereby disclaims the terminal part of the term of any patent granted on the above-identified patent application which would extend beyond the full statutory term of U.S. Patent No. 6,742,734. In addition, Petitioner hereby agrees that any patent so granted on the above-identified patent application shall be enforceable only for and during such period that the legal title to U.S. Patent No. 6,742,734 shall be the same as the legal title to any patent granted on the above-identified patent application, this agreement to run with any patent granted on the above identified patent application and to be binding upon the grantee, its successors, or assigns.

In making this disclaimer, Petitioner does not disclaim any terminal part of any patent granted on the above identified patent application, prior to the full statutory term of U.S. Patent No. 6,742,734 as defined in 35 U.S.C. §§ 154-156 and 173, in the event that U.S. Patent No. 6,742,734 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 U.S.C. § 154, prior to the full statutory term of U.S. Patent No. 6,742,734 as defined in 35 U.S.C. §§ 154-156 and 173, except for the separation of legal title stated above.

Further, Petitioner does not disclaim any terminal part of a patent granted on the above identified patent application that would extend beyond the present termination of U.S. Patent No. 6,742,734, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§ 155, 155A, or 156, and without waiving Petitioner's right to extend the term of a patent granted on the above identified patent application to the extent provided by law.

The undersigned, being the Attorney of Record for the above identified patent application, and duly authorized to act on behalf of Petitioner, certifies that she has reviewed

the Assignment attached as EXHIBITS 1 and 2, and to the best of her knowledge and belief, legal title to the above identified patent application and U.S. Patent No. 6,742,734 rests with Petitioner.

The undersigned declares that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date August 18, 2005

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